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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------------|
| 10/766,697 | 01/27/2004 | Robert Frederick | 120137.481 | 2064 |
| 500 7590 12/13/2007 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104 | | | EXAMINER SHAH, AMEE A | |
| | | | ART UNIT 3625 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/766,697 | Applicant(s) FREDERICK ET AL. | |
| | Examiner Amea A. Shah | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-93 is/are pending in the application.
- 4a) Of the above claim(s) 29-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,21,24,28 and 85-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 16, 21, 24, 28 and 85-93 are examined in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 5, 2007, has been entered.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 21, 24, 28 and 85-93 are rejected under 35 U.S.C. §102(e) as being anticipated by Hazzard et al., US 2005/0125389 A1 (hereafter referred to as “Hazzard”).

Referring to claim 16. Hazzard discloses a computer-implemented method for selling access to Web services to Web service consumers who are unrelated to Web service providers who provide those Web services (*see, e.g.,* Abstract), the method comprising:

- in response to registration requests from providers of Web services, registering Web services so as to make access to those Web services available for purchase by unrelated consumers of Web services, the registered Web services each having at least one associated use price (¶¶0021, 0022 and 0044 – note that the associated use prices are the payment terms);
- providing information about the available registered Web services to consumers of Web services (¶¶0022, 0027 and 0045);
- in response to each of multiple access requests from the consumers, performing a sale to a consumer for access to an indicated one of the registered Web services in exchange for an access fee from the consumer that is based on a use price associated with the indicated Web service (¶¶0045 and 0046);
- after each of at least some sales to a consumer for access to a registered Web service, providing to the consumer access to the registered Web service by invoking that Web service from the provider of the Web service on behalf of the consumer and by providing response information from the invoking to the consumer (¶¶0017, 0019, 0020, 0023, 0025, 0037 and 0045); and
- providing payment for each of the registered Web services to the provider of that Web service based on the access fees paid by the consumers for access to that Web service (¶¶0017 and 0046).

Referring to claim 21. Hazzard further discloses the method of claim 16 wherein the received access requests and the corresponding performed access sales are each for an access subscription for a consumer to a registered Web service (§§0037 and 0045 – note that the method authenticates the user in the subscriber database after receiving an access request).

Referring to claims 24 and 28. Hazzard further discloses the method of claim 21 wherein each access subscription provides a specified multiple number of times that access may be provided, including a single immediate access to a registered Web service such that the providing of the access to the consumer occurs in response to the access request that produced the access subscription (§0046).

Referring to claims 85 and 91. All of the limitations in apparatus claims 85 and 91 are closely parallel to the limitations of method claim 16, analyzed above and are rejected on the same bases.

Referring to claims 86-88. Hazzard further discloses the computer-readable medium of claim 85 wherein the computer-readable medium stores a signal or is a memory of a computing system and the contents are instructions that when executed cause the computing system to perform the method (§0018 – note that the method can be performed by any logic on hardware or software with wireless communication, i.e. signals).

Referring to claim 89. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to one of the available Web services that has been registered by the third-party provider from whom the Web service is available, at least some of the entries including at least one use price and at least one use condition (§§0018-0020 – note the data structures include the directory database of the brokerage module).

Referring to claim 90. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to a subscription purchased by a consumer to one of the registered Web services, each of the entries including criteria indicating whether an attempted use of the subscription for an access of the registered Web service is valid (§§0023 and 0031 – note the data structures include the repository and the security modules).

Referring to claims 92 and 93. All of the limitations in apparatus claims 92 and 93 are closely parallel to the limitations of apparatus claims 86 and 88, analyzed above and are rejected on the same bases.

Response to Amendment

Applicant's amendment, filed November 5, 2007, has been entered. In view of the amendments to the claim 87, and the arguments presented, the 35 U.S.C. §101 rejection is withdrawn.

The declaration of James A. D. White (hereafter referred to as "the Declaration") filed on November 5, 2007, under 37 CFR 1.131 has been considered but is ineffective to overcome the Hazzard reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hazzard reference to either a constructive reduction to practice or an actual reduction to practice. Applicant has previously submitted evidence of conception of the invention prior to the effective date of the Hazzard reference, December 9, 2003 (see Declaration Under 37 C.F.R. §1.131 of Robert Frederick, Ashish Agrawal, and Jeffrey Barr, filed May 31, 2007), in which dates were redacted. The Declaration was provided as an attempt to establish due diligence from prior to the reference date to the filing date of the application (see MPEP §715.07(III)). The Declaration states "[p]rior to the December 9, 2003 filing date of Hazzard, I received a copy of a functional specification..." (paragraph 3), and "[b]eginning prior to the December 9, 2003 filing date of Hazzard, and continuing until the constructive reduction to practice on January 27, 2004... I diligently participated in the preparation of the ... application on a regular basis." (Paragraph 5). The Declaration then lists dates beginning with December 17, 2003 until January 27, 2004, on which preparations for the current application occurred. However, the Declaration does not give any specific dates prior to December 9, 2003, or before December 17, 2007.

The MPEP states in §715.07(II) that the applicant does not need to disclose actual dates for conception and a mere allegation that the acts referred to occurred prior to a specified date is sufficient. The evidence provided by applicant on May 31, 2007, of the declaration of the inventors was therefore sufficient to show conception even though no actual dates were provided

and any dates were blacked out. However, as the MPEP specifically states in §715.07(II), **“the actual dates of acts relied on to establish diligence must be provided”** (emphasis added).

The MPEP further states in §715.07(a),

it is not enough merely to allege that applicant or patent owner has been diligent. Rather, applicant must show evidence of facts establishing diligence. ... In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity (citations omitted).

To establish diligence, the “applicant must account for the entire period during which diligence is required,” MPEP §2138.06. In this case, the applicant must account for the period just prior to December 9, 2003 (i.e. December 8, 2003), until January 27, 2007, when constructive reduction to practice occurred. “The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses,” MPEP §2138.06. In this case, the applicant has accounted by affirmative acts diligence from December 17, 2003, to January 27, 2004. However, the applicant has not provided a specific date prior to December 9, 2003, the beginning of the period from which diligence is required. It is impossible to establish whether the diligence requirement is met because there is no date from which to determine whether the applicant was diligent. For example, was the period of inactivity prior to December 17, 2003, one week, i.e. did the attorney receive the functional specification on December 8, 2003, or was the period of inactivity two years, i.e. did the attorney receive the functional specification in December, 2001? The applicant has not met the diligence requirement because he has not

accounted for the entire period during which diligence is required by either affirmative acts or acceptable excuses. Therefore, the Declaration is ineffective to overcome the Hazzard reference.

Response to Arguments

Applicant's arguments filed November 5, 2007, have been fully considered but they are not persuasive. In response to applicant's argument regarding the Declaration, see above. In response to applicant's arguments that Hazzard is unrelated to providing consumers with paid access to remote Web services by invoking such services from third-party providers on behalf of the consumers (Remarks, pages 22-23), these features are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hazzard discloses the limitations of the claims as discussed above. Furthermore, applicant's argument that each claim features and provides functionality not disclosed by Hazzard fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even

though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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AAS

December 6, 2007


YOGESH C. GARG
PRIMARY EXAMINER
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